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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/562,947

03/13/2008

Eiju Suzuki

Q92273

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23373 7590 09/13/2010  
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EXAMINER

FISCHER, JUSTIN R

ART UNIT

PAPER NUMBER

1791

NOTIFICATION DATE

DELIVERY MODE

09/13/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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USPTO@SUGHRUE.COM

<b>Office Action Summary</b>	<b>Application No.</b> 10/562,947	<b>Applicant(s)</b> SUZUKI ET AL.	
	<b>Examiner</b> Justin R. Fischer	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5,6 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,6 and 10-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 2, 2010 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 5, 6, and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segatta (US 5,396,940, of record) and further in view of Imamura (US 3,913,652, of record) and Scriver (US 4,192,366, of record).

Segatta is directed to a rubber composition comprising 5-95 phr of epoxidized natural rubber (claimed natural rubber), 5-95 phr of cis 1,4 polyisoprene, and 5-85 phr of silica (Column 1, Lines 63+). In this instance, given the general disclosure of Segatta, one of ordinary skill in the art at the time of the invention would have found it obvious to form a composition consisting of natural rubber and cis 1,4 polyisoprene within the claimed loadings (i.e. natural rubber expressly disclosed as being included at 95 phr).

While Segatta is silent with respect to the cis 1,4 content and associated Mooney viscosity, the claimed characteristics are consistent with the conventionally used

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polyisoprene rubbers in the tire industry, as shown for example by Imamura (Column 2, Lines 22-25) and Scriver (Column 2, Lines 20-25). Absent any conclusive showing of unexpected results, one of ordinary skill in the art at the time of the invention would have found it obvious to use the claimed cis 1,4 polyisoprene.

As to claims 5 and 6, the composition of Segatta includes between 5 and 85 phr of silica having a surface area between 40 and 600 m<sup>2</sup>/gram. Absent any conclusive showing of unexpected results, one of ordinary skill in the art at the time of the invention would have found it obvious to select a surface area of at least 180 m<sup>2</sup>/gram.

Regarding claims 10 and 11, the language "used for tread" and "used for a casing member" do not further define the makeup of the claimed rubber composition.

As to claim 12, the rubber composition of Segatta is used for the manufacture of tire treads and/or carcass plies (casing member).

With respect to claims 13 and 14, the disclosed loadings would have been obvious to one having ordinary skill in the art since they are consistent with "typical" or conventional loadings, as shown for example by Scriver. It is further noted that applicant has not provided a conclusive showing of unexpected results to establish a criticality for the claimed loadings.

### ***Response to Arguments***

4. Applicant's arguments filed August 2, 2010 have been fully considered but they are not persuasive. It is noted that the rejections with Ueda have been withdrawn in light of applicant's amendments. However, the previous communications also included rejections with Segatta and such rejections remain applicable.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Justin R. Fischer** whose telephone number is **(571) 272-1215**. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Justin Fischer  
/Justin R Fischer/  
Primary Examiner, Art Unit 1791  
September 2, 2010